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REMARKS

Claims 1-20 remain in the application.

§102 Rejections

Claims 1-7, 9, 11-16, 18 and 20 were rejected under §102 as anticipated by Jigamian. Jigamian discloses a battery-powered searchlight with an adjustable light level. The light level is determined by sustained pressure on a single switch, during which the intensity ramps up, with the intensity being set at the level at which the switch is released. The same switch turns the lamp off, and back on at the last selected intensity (paragraph 82).

The rejection of claim 1 is in error because the cited reference does not disclose all of the elements of the claim.

The first error in the rejection of claim 1 is in the assertion that the cited reference discloses a switch operable to be incremented through a sequence of states. The action cites element 88, paragraph 82. Element 88 is shown in Figure 14 as a simple switch with an open and a closed state, not a "sequence." Applicant intends the term "sequence" to have the normal meaning, in which there is a series of states more than two. The action merely cites a text passage, without explaining how an "open/closed" switch has a sequence of states.

The latest action again raises applicant's allegation that an open/closed switch cannot have a sequence of states, but fails to offer any evidence to refute the allegation. Moreover, contrary to the statements in the action, applicant's claim does not recite a switch "hav(ing) a sequence of states" nor one that can "operate through a sequence of states" (though these may also be patentable). More precisely, applicant is claiming a switch "operable to be incremented through a sequence of states", and that the implementation occurs "in response to an application and release of pressure". None of the cited elements in the cited reference fulfill this requirement, let alone the other claim limitations.

The action asserts incorrectly that the cited reference discloses "a single switch that employs a plurality of cooperating elements to perform a single switching function that is commensurate with Applicant's claimed switch." This is improper first because novelty rejections are not supported by citing elements merely having "commensurate function." This is further improper because the action does not indicate what elements are being referred to,

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making a response impossible. The citation of a major portion of a paragraph without the indication of an element number is legally inadequate. Even if applicant's claimed device had the identical function as the cited reference (it does not), that would not be adequate basis to reject a claim having a novel structure of elements to provide that function. But nothing of the cited reference, including any asserted combination of elements, discloses "a single switch operable to be incremented through a sequence of states."

In addition, the latest action does not deny that the cited switch 88 has only an off state and an on state, but points to another different element (resistance ladder 146) allegedly having a sequence of states, without any indication of how that different element is operable to meet the other requirements of applicant's claim switch (no evidence is offered that the resistance ladder 146 operates to change state in response to an application and release of pressure). This is inadequate to support the rejection, because a claim element is not disclosed by a reference with one element having one of the claim element features, and a second element having another of the claim elements features. A proper rejection must cite an element that discloses all of the claimed element's features. The point is not that switches having a sequence of states do not exist, but that such switches are not employed in the manner claimed by applicant (and no such switches are disclosed in the cited reference.)

The latest action simply repeats the prior response to arguments on the above topics, and did not address applicant's arguments. This fails to comply with MPEP requirements that an Office action address applicant's arguments.

An additional error in the rejection of claim 1 is in the assertion that the cited reference discloses a switch that, upon application and release of pressure, changes between states in which the lamp is operated at different brightness. The cited passage of paragraph 82 states that "momentary depression" (application and release of pressure) of the button (switch) 88 turns on the light, and another application and release of pressure turns off the light. Switching between an on state and an off state is not the same as switching between operating a lamp at two brightness levels, because an "off" lamp is not operating.

The latest action notes that the cited reference's switch 88 provides a selectable range of brightness based on the duration the switch is pressed. The action points out that applicants claim does not specify a particular duration of depression. This is true, as applicant is claiming

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merely responsiveness in the stated manner to an application and release of the pressure, without regard to duration or interval. However, what applicant is claiming is that such an application and release the pressure simply increments from one brightness state to another in sequence. The cited reference does not respond to application and release to increment to a next state in a sequence, even if it permits selection within a brightness range. Selecting brightness based on duration of pressure has no relation to sequence, as any selected brightness may be obtained based on applying pressure for a corresponding selected duration. For this additional reason, claim 1 is patentably distinct from the cited reference.

The action asserts that applicant has argued that the prior art switch "requires use of other elements". Applicant has not used this argument, and the action is presumed to be paraphrasing, although it is unclear what argument of applicant is being addressed. Applicant requests that any assertion regarding applicant's arguments quote the language used, or at least identify a page and paragraph of the argument. That being said, there is no element or collection of elements in the cited reference that disclose a switch operable to be incremented through a sequence of states.

For either one of the above reasons, the rejection of claim 1 is in error, and claim 1 and its dependents should be allowable.

Claims 2-11 depend from claim 1 and should be allowable for the above reasons and because of the features set forth therein. **The latest Action did not address applicant's arguments, below, but merely repeated the "response to applicant's arguments" from the prior action. This fails to meet the Examiner's duty to consider and address applicants arguments. There is no exception for dependent claims, and applicant had italicized new portions to ensure that they were considered and addressed.**

Claim 2 should be allowable for the additional reason that the cited reference does not disclose a "switch (that) includes an off state in addition to at least two different brightness states." The cited reference is capable of multiple output levels and an off condition, but the cited reference's switch is not, *even if the switch is operable to generate a range of operating states in the flashlight (noting that the cited reference may have a range of operating states, but not a sequence)*. The cited switch has only two states, not two different brightness states in addition to an off condition. For this additional reason, claim 2 should be allowable.

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Claim 4 should be allowable for the additional reason that the action does not allege that the cited reference discloses a switch having a plurality of outputs connected to the controller. The element 164 cited as a controller is connected to switch element 88 by only a single input. *The action appears to argue that a controller having only a single connection to the switch, but additional connections to other circuitry that allegedly have switching functions, discloses a "switch having a plurality of outputs connected to the respective controller inputs."* The question is not whether the controller has multiple inputs connected to various switching devices, but whether the elements cited as the switch has multiple outputs connected to the controller. *The action makes no such allegation, and thus the rejection is unsupported.*

Claim 5 should be allowable for the additional reason that the cited switch is incapable of the claimed connection, for the reasons set forth with respect to claim 4, *and because the mere existence of a switch that controls a resistance ladder does not disclose the making of the connection between a controller input and a selected one of the switch outputs.*

Claim 6 should be allowable for the first additional reason that the action fails to point out where the cited reference discloses a "power storage element (having) opposed electrodes each connected to the controller." The action merely cites a figure (2) and element number (237) for the power storage element, but does not identify electrodes, nor any means of connection, nor an element in the figure that is alleged to be a controller. The element 164 cited elsewhere as a controller is not found in the cited figure, and the figure (14) in which this element is displayed does not disclose an element with a number corresponding to the cited power storage element.

Claim 6 should be allowable for the second additional reason that the action fails to point out where the cited reference discloses a "lamp (having) opposed electrodes each connected to the controller." The action merely cites a figure (2) and element number (66) for the lamp, but does not identify electrodes, nor any means of connection, nor an element in the figure that is alleged to be a controller. The element 164 cited elsewhere as a controller is not found in the cited figure, and the figure (14) in which this element is displayed does not disclose an element with a number corresponding to the cited lamp.

The latest action argues that it is inherent that a battery has positive and negative electrodes with a connection to a controller/switch. Of course, this is not what applicant is claiming. The action fails to disclose where the cited reference shows the power storage electrodes each

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connected to the controller and the lamp electrodes each connected to the controller. There is nothing inherent about this claimed configuration. The action further misstates applicant's argument, incorrectly stating that a applicant argued that the cited reference does not disclose a lamp having opposed electrodes. Applicant never argued this, nor does applicant's case for patentability rest on such a notion. Applicant's claim is based on the connection configuration, which is not disclosed in the cited reference.

Claim 7 should be allowable for the additional reason that the action does not allege that the cited reference discloses all contacts of the switch being connected directly to the controller, such that the switch does not intervene between the lamp and the power source. The latest action refers to a controller/switch 164 with a plurality of contacts including switch contacts connected directly to the controller and not intervening between the lamp and power source 88. This does not appear to logically relate to the claim, because it appears to allege a controller having contacts to itself, and appears to confuse the power source and switch elements. Inasmuch as the rejection is understood, it is traversed because the action does not point out with particularity a switch with multiple contacts, all of which are connected directly to a controller.

Claim 9 should be allowable for the additional reason that the cited reference does not disclose a resistor network connected and operating as claimed. The action cites a circuit including a lamp and a power source, but provides no evidence that the pertinent switch operates in any way to include a resistor in the circuit, nor that the operation is to include a selected one of the resistors in a circuit.

Claim 12 should be allowable because the action fails to allege that the cited reference discloses the claimed elements, relying on assertions with respect to claim 1, or because certain claimed elements are not disclosed in the cited reference.

The action did not appear to consider or address any of applicant's new arguments with respect to independent claim 12 offered in response to the prior action and below, and repeated verbatim the same "Response to Applicant's Arguments" as before.

The first error in the rejection of claim 12 is that the action improperly cites one element as a switch for one purpose, and another different element as a switch for another purpose. The action does not cite a single element that satisfies all the requirements for applicant's claimed

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switch. The switch 88 may satisfy some of the claim requirements, and the controller 164 may satisfy others, but this does not provide adequate basis to reject the claim in which a switch is claimed as having all of these characteristics.

The second error in the rejection of claim 12 is that the cited reference does not disclose a "switch being operable to be incremented through a sequence of states." As discussed above, an on-off switch does not have a sequence of states, *and the fact that it controls something else that may have a range of states (if not a sequence) does not change the reality that the switch itself does not have a sequence of states.*

The third error in the rejection of claim 12 is that the action fails to allege that the cited reference discloses "each of the states having an electrical connection made between the input contact and a respective one of the output contacts." *The action argues that the above is inherent, when in fact it is impossible, in the absence of any indication of what constituted the input contact and the one of the output contacts in the cited reference.*

Claims 13-20 depend from claim 12 and should be allowable for the above reasons and because of the features set forth therein. **The latest Action did not address applicant's arguments, below, but merely repeated the "response to applicant's arguments" from the prior action. This fails to meet the Examiner's duty to consider and address applicants arguments. There is no exception for dependent claims, and applicant had italicized new portions to ensure that they were considered and addressed.**

Claim 13 should be allowable for the additional reason discussed above with respect to claim 2.

Claim 14 should be allowable for the additional reason that *the action argues in multiple instances that various elements (88, 164) constitute switches, yet argues for the purpose of claim 14 that the reference includes only a single switch.*

Claim 15 should be allowable for the additional reason that *the office action continues to fail to point out with particularity where and how the controller is connected to each of the cited elements. Applicant requests that if the rejection is to be maintained, that an element number for each of the cited elements in each cited figure be provided. For instance, cited figure 2 does not appear to disclose a controller element 164, and no element numbers for a switch or switch*

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contacts are provided. Similarly figure 10 does not appear to contain me a battery to 37 nor any numbered elements corresponding to a cited switch or its contacts.

Claim 16 should be allowable for the additional reasons discussed above with respect to claim seven.

Claim 18 should be allowable for the additional reason discussed above with respect to claim 9.

Claim 20 should be allowable for the additional reason discussed above with respect to claim 11.

§103 Rejections

Claims 8, 10, 17 and 19 were rejected under §103 as unpatentable over Jigamian. The rejection blurs the different features of these claims together, without making an adequate or coherent case for any of the particular features. **The new action does not address this issue, and fails to properly reject the claims.**

Claim 8 should be allowable because the action provides inadequate motivation to make the proposed modification of Jigamian, by substituting a multi-contact switch with a rotating element for the simple open-closed switch. The asserted motivations appear to be drawn in hindsight based on applicant's disclosure. In addition, the "single-button" simplicity motivation is inadequate because Jigamian is already single button operation.

Claim 10 should be allowable because the action provides inadequate motivation to make the proposed modification of Jigamian, to adopt an LED. This modification appears to be drawn in hindsight based on applicant's disclosure. Moreover, the reference teaches away from the adoption of an LED because there is no evidence that the function of a high brightness xenon arc light searchlight could be performed by an LED, regardless of efficiency. In addition, the action offers no evidence that an LED is more efficient than an arc lamp.

Claims 17 and 19 should be allowable for the reasons discussed above with respect to claims 8 and 10, respectively.

Claims 1, 2, 8, 12, 13 and 17 were rejected under §103 as unpatentable over applicant's admitted prior art. The rejection lumps together all of the claims, without pointing out where

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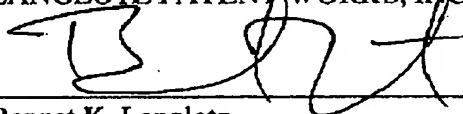
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each of the claimed elements is disclosed in the admitted prior art. Moreover, the action does not reference specific elements or parts relied on admitted by applicant as required by 37 CFR 1.104c2. Applicant notes for the record that the words used by examiner were not used by applicant, and thus are not admitted. Moreover, the broad citation of extended paragraphs is inadequate to allow applicant to refute the assertions, because it is unclear what elements are being cited as disclosing claimed elements. This is especially problematic inasmuch as 6 different claims are rejected, but many of the claimed elements are not alleged to be disclosed in the Action's created list of "admitted" elements.

Applicant also traverses the legal citation of McLaughlin, a 35-year-old CCPA case that does not state what is asserted. The action appears to suggest that hindsight is a legitimate basis for rejection, although this is not what the law holds. The fact that one looks to what would have been known to one skilled in the art at the time does not support scrapping the long-held prohibition on hindsight as a basis for rejection. If such an assertion is to be continued, applicant requests that the action quote language from any such case to support the assertion.

All pending claims should be allowable for the above reasons. Reconsideration of the application is respectfully requested.

Respectfully submitted,
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